

REMARKS

Applicant amends the claims to include, among other limitations, the limitation recited in claim 5. Accordingly, claim 5 has been cancelled. However, because claim 5 was rejected as being rendered obvious by *Katz*, it is useful to consider that rejection in detail.

The Office's position in rejecting claim 5 was that the photograph recited in the claim was "only found in the nonfunctional descriptive data" and that it was "not functionally involved in the steps recited." The Office then cited *Gulack* and *Lowry* to support the proposition that the transmission of a photograph could not be relied upon to distinguish *Katz*.

Gulack and *Lowry* addressed the patentability of printed matter on a substrate. *Gulack* concerned a claim to an article having a substrate on which certain numbers had been printed. *Lowry* concerned a claim to a memory storing a certain data structure, which the Examiner regarded as analogous to printed matter on a substrate. In both cases, the claims at issue were manufacture claims. Neither of these cases are relevant to method claims such as claim 1.

The Office appears to have relied on *Gulack*'s statement that

"Where the printed matter is not functionally related to the substrate, the printed matter will not distinguish the invention from the prior art in terms of patentability. Although the printed matter must be considered, in that situation it may not be entitled to patentable weight."

In doing so, the Office attempted to apply a holding developed for manufacture claims to a method claim by simply replacing "substrate" with "steps recited." However, this substitution makes no sense. An article of manufacture can have a substrate with printed matter; a method cannot.

There is no requirement that an object be "functionally involved in" a recited step before the step can be considered in distinguishing prior art. In fact, it is not altogether clear what it means for an object to be "functionally involved in" a step. It would appear, however, that if a step involves transmitting a photograph, the photograph is "functionally involved in" the step because without it, the step could not possibly be executed.

The Office then suggests that one of ordinary skill in the art would have found it obvious to modify *Katz* to include transmitting a photograph because a photograph “does not functionally relate to the steps in the method claimed.”

One of ordinary skill in the art would have no had way of knowing what “the steps in the method claimed” were. This is because the only way one of ordinary skill in the art could have known “the steps in the method claimed” would have been by reading “the method claimed.” But “the method claimed” would only be found in Applicant’s specification, and therefore would not have been available to one of ordinary skill in the art at the time the invention was made. Accordingly, the proposed basis for modifying *Katz* improperly relies on Applicant’s disclosure.

The Office also suggests that one of ordinary skill in the art would have found it obvious to modify *Katz* to include transmitting a photograph because “the subjective interpretation of the data does not patentably distinguish the claimed invention.”

Once again, the Office relies on Applicant’s disclosure as a basis for supplying the motivation to modify the reference. One of ordinary skill in the art would have had no way of knowing whether or not “subjective interpretation of the data” would “patentably distinguish the claimed invention.” This is because without having first read Applicant’s disclosure, one of ordinary skill in the art would have had no way of knowing what “the claimed invention” might be.

CONCLUSION

Now pending in this application are claims 1, 3-4, 6-15, and 21-23, of which claims 1, 14, and 21 are independent. Please apply the charges for the request for examination and extension of time, along with any other charges or credits, to our deposit account 06-1050, referencing Attorney Docket No. 08575-0110001.

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Respectfully submitted,

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